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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,622	01/12/2001	Karl Tryggvason	TRV 20011-2	3161

7590

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Richard J. Minnich  
Fay, Sharpe, Fagan, Minnich & McKee  
Suite 700  
1100 Superior Avenue  
Cleveland, OH 44114-2518

EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 01/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/759,622

Applicant(s)

Tryggvason et al

Examiner

Jeffrey Fredman

Art Unit

1655



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 4-9 and 11-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 4-9 and 11-18 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other.

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 4, 5 and 13-16, drawn to Nephhrin proteins and antibodies, classified in class 530, subclasses 350, 387.1 and 388.1.
  - II. Claims 6-9, drawn to methods of protein detection, classified in class 435, subclass 7.1.
  - III. Claim 11, drawn to a method of protein therapy, classified in class 514, subclass 2.
  - IV. Claim 12, drawn to antisense or gene therapy, classified in class 514, subclass 44 and class 536, subclass 24.5.
  - V. Claims 17 and 18, drawn to methods of screening for small molecules, classified in class 436, subclass 501.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions in Group IV and in Groups I, II, III, and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the Group IV methods are drawn to methods of using nucleic acids while the Group I, II, III and V products and methods are drawn to proteins, antibodies and methods of using proteins and antibodies. These methods have different modes of operation since the nucleic acid

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methods utilize nucleic acid hybridization while the protein methods use protein-protein binding. Further, they have different effects since the nucleic acid methods yield information regarding the presence or absence of nucleic acids and the protein methods yield information regarding the status of the proteins. Finally, the proteins and nucleic acids themselves represent structurally different molecules with different chemical characteristics, different methods of making and using and different functions and effects.

4. Inventions in Group I and in Groups II, III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the protein and antibody products of Group I can be used in the detection method of Group II, in methods assaying protein function, in epitope mapping methods, in the therapy method of Group III and in the small molecule screening methods of Group V.

5. Inventions in Groups II, III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the diagnostic method of Group II has a different mode of operation than the treatment method of Group III, both of which differ from the small molecule screening method of Group V, since the Group II

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method has a different function, to identify disease not treat it or identify compounds which might be useful in treatment and different effects such as determining the disease state while the Group III method would treat the disease state and the Group V method would result in the identification of molecules which would be candidates for use in a treatment method.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. A telephone call was made on November 21, 2001 to Briam Bembenick to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Fredman, Ph.D. whose telephone number is (703) 308-6568.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission via the P.T.O. Fax Center located in Crystal Mall 1. The CM1 Fax Center numbers for Technology Center 1600 are either (703) 305-3014 or (703) 308-4242. Please note that the faxing of such papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).



**Jeffrey Fredman**  
**Primary Patent Examiner**  
**Art Unit 1634**

January 18, 2002